

REMARKS

By this Amendment, Claims 1-3 and 5-20 have been canceled, leaving Claims 4, 21 and 22 pending in the application. Applicants respectfully submit that the amendments (a) do not raise any new issue that would require further search and or consideration; (b) do not raise the issue of new matter; (c) place the application in better form for appeal; and (d) do not present any additional claims. Accordingly, the amendments should be entered. Reconsideration of the Official Action is respectfully requested.

1. Rejection of Claims 1-3, 7, 9 and 16-20 Under 35 U.S.C. § 103

Claims 1-3, 7, 9 and 16-20 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 5,133,367 to Keritsis in view of U.S. Patent Application Publication No. 2002/0110689 A1 to Hu et al. ("Hu"). The reasons for the rejection are stated at pages 2-4 of the Official Action. In light of the cancellation of Claims 1-3, 7, 9 and 16-20, this rejection is moot.

2. Rejection of Claims 4, 21 and 22 Under 35 U.S.C. § 103

Claims 4, 21 and 22 stand rejected under 35 U.S.C. § 103(a) over Keritsis in view of Hu, and further in view of U.S. Patent No. 3,241,520 to Wurster et al. ("Wurster"). The reasons for the rejection are stated at pages 4-5 of the Official Action. The rejection is respectfully traversed.

Claim 4 recites a process for making flavored carbon particles, comprising "(i) introducing activated carbon particles into a vessel; (ii) introducing a fluidizing gas into the vessel so as to fluidize the activated carbon particles; and (iii) introducing a liquid flavorant into the vessel while the activated carbon particles are in a fluidized state, the liquid flavorant being absorbed and/or adsorbed onto the activated carbon

particles; wherein the process is carried out in a continuous manner without heating the activated carbon particles, the vessel containing a plurality of compartments through which the activated carbon particles pass sequentially while in the fluidized state" (emphasis added). The applied references fail to suggest the process recited in Claim 4 for the following reasons.

The Official Action asserts that Keritsis discloses that flavorants deposited on activated carbon particles in the filter section of a smoking article are well known in the tobacco art. The Official Action acknowledges that Keritsis fails to disclose flavorants deposited on carbon particles by introducing a fluidizing gas into a vessel to fluidize the particles, and introducing a flavorant into the vessel to absorb and/or adsorb onto the particles. However, the Official Action asserts that depositing material onto activated carbon particles utilizing a continuous or periodic process, fluidized bed coater is well known and disclosed in Hu. The Official Action also asserts that it would have been obvious to utilize a fluidized bed coating to adsorb flavorant onto carbon particles, which will be incorporated into a filler for a cigarette, "since depositing material on carbon particles via fluidization is known in many arts." The Official Action acknowledges that the combination of Keritsis and Hu fails to suggest a process "carried out in a vessel containing a plurality of compartments through which the activated carbon particles pass sequentially while in the fluidized state." However, it asserted in the Official Action that Wurster discloses such features.

Applicants respectfully submit that no *prima facie* case of obviousness has been established. According to MPEP § 2143, for the Patent Office to establish a prima facie case of obviousness, "(1) there must be some suggestion or motivation,

either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings"; (2) "there must be a reasonable expectation of success"; and (3) "the prior art reference (or references when combined) must teach or suggest all the claim limitations." Furthermore, "[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification" (emphasis added). In re Fritch, 23 USPQ2d 1780, 1783-84 n. 14 (Fed. Cir. 1992). Applicants respectfully submit that the Official Action has not established a prima facie case of obviousness regarding the subject matter recited in any one of Claims 4, 21 and 22.

Keritsis discloses a container for an additive material for smoking articles. The container is designed for the purpose of overcoming problems encountered when additive materials are added to smoking articles in an exposed condition. Keritsis explains that "menthol and other flavorants deposited on carbon, silica, and other activated particles in the filler section of a smoking article have been used to impart a flavor or taste to the smoking article" (emphasis added; column 1, lines 33-37, of Keritsis). The Official Action acknowledges that Keritsis fails to disclose how such flavorants are deposited on activated carbon particles.

However, Keritsis not only fails to suggest how such flavorants may be deposited on activated carbon particles, but discourages using such particles in smoking articles at all. Particularly, Keritsis discloses that problems occur when activated carbon particles having flavorants deposited on them are added to smoking articles, and that its purpose is to overcome such problems. See, for example, column 1, lines 42-65, of Keritsis. In light of these problems, Keritsis provides the

sealed containers for use in smoking articles. The sealed containers have a first sealed condition, and a second condition that allows air flow through the container so that the additive material can modify the characteristics of the smoking article (column 3, lines 42-49). According to Keritsis, additive materials that have active agents that deactivate over time or in moist or humid storage conditions, or that evaporate or volatilize or migrate during prolonged storage, can be contained in the container. However, Keritsis' sealed container, which contains an additive material in a sealed condition for use in cigarettes, is completely unrelated to providing the additive material in an exposed condition on activated carbon particles for use in cigarettes.

Hu fails to cure the deficiencies of Keritsis regarding the process recited in Claim 4. Hu discloses activated carbon particles coated with water-insoluble coating material for coloring purposes. The colored activated carbon can be placed in absorbent articles in place of uncoated, black activated carbon. Hu also discloses that certain coatings can be delivered to activated carbon, particularly "a deformable opaque or colored coating [can be delivered] to activated carbon, including an elastomeric coating" (page 3, paragraph [0021], lines 12-13). Hu discloses a "typical" coater and its operation at page 3, paragraph [0021], line 13 *et seq.* As acknowledged in the Official Action, Hu also does not suggest the feature that "the process is carried out in a continuous manner without heating the activated carbon particles, the vessel containing a plurality of compartments through which the activated carbon particles pass sequentially while in the fluidized state" (emphasis added), as recited in Claim 4.

Although Hu discloses coating activated carbon particles with a fluidized bed, Hu fails to suggest coating flavorant onto any particles by any process, much less by “introducing a liquid flavorant into the vessel while the activated carbon particles are in a fluidized state, the liquid flavorant being absorbed and/or adsorbed onto the activated carbon particles” (emphasis added), as recited in Claim 4.

Wurster fails to cure the deficiencies of Keritsis and Hu regarding the process recited in Claim 4. Wurster discloses a particle coating apparatus for applying coatings to particles essentially suspended in a moving gas stream. Wurster does not disclose or suggest coating activated carbon particles, much less coating them with a flavorant. As such, Wurster also fails to provide any motivation to modify Keritsis to achieve the process recited in Claim 4, including the feature of “introducing a liquid flavorant into the vessel while the activated carbon particles are in a fluidized state, the liquid flavorant being absorbed and/or adsorbed onto the activated carbon particles.”

Applicants respectfully submit that Wurster also fails to suggest modifying Hu's coating process such that “the process is carried out in a continuous manner without heating the activated carbon particles, the vessel containing a plurality of compartments through which the activated carbon particles pass sequentially while in the fluidized state” (emphasis added), as recited in Claim 4.

In summary, the only disclosure of coating flavorant onto particles by a fluidized bed process is Applicants' disclosure. Keritsis only parenthetically (and without detail) mentions “flavorants deposited on carbon.” Hu and Wurster provide no suggestion of applying flavorant onto any particles, much less onto activated carbon particles. Thus, Hu and Wurster do not suggest applying any such flavorant

onto activated carbon particles by using a fluidized bed process. Therefore, Hu and Wurster provide no motivation to modify Keritsis to achieve the claimed process, which includes the feature of "introducing a liquid flavorant into the vessel while the activated carbon particles are in a fluidized state."

The applied references also fail to suggest the desirability of the modification of Keritsis asserted in the Official Action. Keritsis teaches that problems occur when flavorants are provided on activated carbon particles for use in smoking articles. Hu does not suggest depositing flavorant onto any particles, much less activated carbon particles. In light of these deficiencies, Keritsis and Hu would not have suggested the desirability of the asserted modification of Keritsis to one skilled in the art.

The intended function of the invention disclosed in Keritsis is to maintain the additive material in a sealed condition. However, the asserted modification of Keritsis in view of Hu would, in direct contrast, result in the additive material being exposed. Because the asserted modification of Keritsis in view of Hu would destroy the intended function disclosed in Keritsis, the applied references provide no suggestion or motivation to make the asserted modification to attempt to achieve the process, as recited in Claim 1. See MPEP § 2143.01, page 2100-127, left column.

Accordingly, for at least the above reasons, the Official Action has failed to establish a *prima facie* case of obviousness for the process recited in Claim 4. Thus, the process recited in Claim 4 is patentable over the applied references. Dependent claims 21 and 22 also are patentable for at least the same reasons as those stated for Claim 4. Therefore, withdrawal of the rejection is respectfully requested.

3. Rejection of Claims 5 and 6 Under 35 U.S.C. § 103

Claims 5 and 6 stand rejected under 35 U.S.C. § 103(a) over Keritsis in view of Hu, and further in view of U.S. Patent No. 3,889,691 to Urbanic et al. ("Urbanic"). The reasons for the rejection are stated at page 5 of the Official Action. In light of the cancellation of Claims 5 and 6, this rejection is moot.

4. Rejection of Claim 8 Under 35 U.S.C. § 103

Claim 8 stands rejected under 35 U.S.C. §103(a) over Keritsis in view of Hu, and further in view of "Controlling particle size and release properties" by David M. Jones ("Jones"). The reasons for the rejection are stated at pages 7-8 of the Official Action. In light of the cancellation of Claim 8, this rejection is moot.

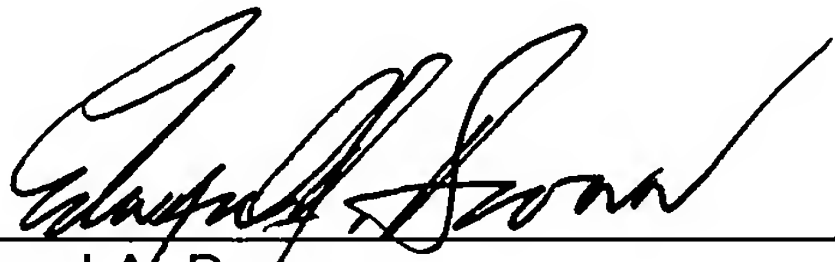
5. Conclusion

For the foregoing reasons, withdrawal of the rejections and prompt allowance of the application are respectfully requested.

Respectfully submitted,

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